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**Filed** : **July 28, 2003**

### **AMENDMENTS TO THE DRAWINGS**

New FIG. 3A-1 is attached hereto in the Appendix. New FIG. 3A-1 shows a first lens support being configured to allow the first lens to pivot relative to the frame between at least first and second positions, wherein the lens provides a first magnitude of light attenuation when the first lens is in a first position and less light attenuation when the first lens is pivoted to the second position.

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### REMARKS

Applicants thank the Examiner for his careful and thoughtful examination of the present Application. By way of summary, Claims 14-29 were pending. With the present Response, Claims 30-33 are added; therefore, Claims 14-33 are now pending in this Application. In response to the Office Action mailed June 14, 2005, Applicants respectfully request the Examiner to reconsider the above-captioned Application in view of the following comments.

#### The Drawings Comply With MPEP § 608.02(d)

The Office Action objected to the drawings for failing to show “[a first lens support being configured to allow] the first lens to pivot relative to the frame between at least first and second positions, wherein the lens provides a first magnitude of light attenuation when the first lens is in a first position and less light attenuation when the first lens is pivoted to the second position.” Office Action of June 14, 2005, page 2. New FIG. 3A-1 has been added in the attached Appendix to show the element described above.

The drawing amendments are supported throughout the originally filed specification. For example, at paragraph no. [0055] the originally filed specification states:

Preferably, the lenses 44, 46 are configured to provide variable light attenuation. For example, each of the lenses 44, 46 can comprise a pair of stacked polarized lenses, with one of the pair being rotatable relative to the other. For example, each lens of the stacked pairs can comprise an iodine stained polarizing element. By rotating one lens relative to the other, the alignment of the polar directions of the lenses changes, thereby changing the amount of light that can pass through the pair. U.S. Patent No. 2,237,567 discloses iodine stained polarizers and is hereby expressly incorporated herein by reference. Additionally, rotatable lens designs are disclosed in U.S. Patent No. 4,149,780, which is hereby expressly incorporated herein by reference.

Accordingly, Applicants respectfully submit that no new matter is introduced by the proposed drawing changes and therefore respectfully request the Examiner to withdraw the objection to the drawings.

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The Applied Combination of Swab, et al./Bylander Does Not Make Obvious Claims 14-21

Claims 14-21 stand rejected under 35 U.S.C. § 103(a) as being obvious over Swab, et al. in view of Bylander. Applicants respectfully traverse the present rejection.

Swab, et al. teach eyewear with a transceiver for forming ad hoc networks. However, as admitted by the Office Action, nothing in Swab, et al. teaches or suggests any devices for changing the light attenuation provided by the lenses thereof.

Bylander teaches a variable light attenuation system for eyewear that uses electronically controllable dyes to change the magnitude of the light attenuation; however, nothing in Bylander teaches or suggests that such a system should or could be combined with eyewear that has other electronic systems. Rather, as discussed in the Request for Reconsideration of March 30, 2005, the Office Action relies on improper hindsight reasoning to provide the motivation for combining the references, as will be discussed in greater detail below.

Section 2143 of the M.P.E.P. states that to establish *prima facie* obviousness three requirements must be met:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure.

M.P.E.P. § 2143.01 (8<sup>th</sup> ed., rev. 3 August 2005). The Office Action fails to provide the required showings to establish a *prima facie* case of obviousness in that there has been no showing of a suggestion or motivation to combine, there has been no showing of a reasonable expectation of success, and even if combined, the cited references fail to teach or suggest all the claim limitations.

In combining the cited references the Office Action states:

Because Swab et al[.] and Bylander are both from the same field of endeavor, the purpose of controlling the amount of light that is transmitted through the lens as disclosed by Bylander would have been recognized as an art pertinent [to] Swab et al.

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It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglass frame, such as the one disclosed by Swab et al[.], with the lens configured to have variable light attenuation, such as disclosed by Bylander . . . .

Office Action of June 14, 2005, page 4 (emphasis added). The Office Action appears to rely upon the level of skill of a person having skill in the art to be motivated to combine the cited references. However, the Federal Circuit has clearly explained, “The level of skill in the art cannot be relied upon to provide the suggestion to combine references.” M.P.E.P. § 2143.01 (8<sup>th</sup> ed., rev. 3 August 2005) (citing al-Site Corp. v. VSI Int’l Inc., 174 F.3d 1308, 50 U.S.P.Q.2d (BNA) 1161 (Fed. Cir. 1999)).

In addition, in another case where the Federal Circuit vacated and remanded a ruling by the Board of Patent Appeals and Interferences, the Federal Circuit commented on an Examiner’s rationale for combining references on the grounds of general knowledge in an obviousness rejection. The Court stated:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to use that which the inventor taught against its teacher.

In re Lee, 277 F.3d 1388, 1343, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002) (quoting W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. (BNA) 303, 312-13 (Fed. Cir. 1983)). As in Lee, the Office Action appears to be relying upon “subjective belief and unknown authority,” and no factual evidence of motivation, as required.

Thus, it appears that the Office Action has impermissibly used hindsight derived from the teachings in the present Application, and not the teachings of the prior art, to reject independent Claims 14 and 22. Recently, the Federal Circuit reiterated the importance of “particularly identifying any suggestion . . . to combine . . . references,” to avoid what the court deemed as “hindsight-based obviousness analysis.” In re Dembiczak, 175 F.3d 994, 50 U.S.P.Q.2d (BNA) 1614 (Fed. Cir. 1999). In Dembiczak, the Federal Circuit held that that the Board did not particularly identify a suggestion to combine, among other things, a design patent depicting a bag with a jack-o-lantern face, conventional plastic trash bags, and a book showing how to make a paper bag pumpkin by stuffing a trash bag full of newspapers. The Court reiterated that a

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determination of obviousness cannot simply rely on the inventor's disclosure as a "blueprint" without evidence of a suggestion, teaching or motivation in the prior art. Therefore, the Court did not allow the Board to sustain an obviousness rejection of claims to large trash bags resembling pumpkins or jack-o'-lanterns.

Similar to Dembiczak, the Applicants submit that the Office Action fails to meet its burden of providing some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the disclosure of the Swab, et al. patent, and combine it with the disclosure of the Bylander patent. See M.P.E.P. § 2143 ("The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure.").

Additionally, in Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 38 U.S.P.Q.2d (BNA) 1551 (Fed. Cir. 1996), the Federal Circuit agreed with the district court that there "is no teaching or suggestion whereby a person of ordinary skill would have been led to select [the claimed] mechanical and electrical structures and concepts and combine them as did DeMayo in the '114 invention." Applicants assert that there is similarly no teaching or suggestion whereby a person of ordinary skill would have been led to select the mechanical and electrical structures and concepts of Swab, et al. and Bylander and combine them as combined by the Office Action.

In Sensonics, the Federal Circuit concluded, "To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction – an illogical and inappropriate process by which to determine patentability." Id. (citing W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983)). Similarly, in the present case, the Office Action draws on hindsight knowledge of the claimed invention in that the cited references do not contain or suggest the combination, motivation to combine, or likelihood of success in doing so.

The Office Action of June 14, 2005 states:

[I]t must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure such a reconstruction is proper.

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Office Action of June 14, 2005, page 5 (citing In re McLaughlin, 443 F.2d 1392, 170 U.S.P.Q. 209 (BNA) (C.C.P.A. 1971)). However, as discussed above, the Office Action does not provide any factual evidence that one of skill in the art would be motivated to combine the cited references based upon the cited reference or based upon the general knowledge of those of skill in the art; instead, the Office Action's motivation to combine the references improperly comes solely from knowledge gleaned only from the Applicant's disclosure.

Referring back to the second requirement to establish a *prima facie* case of obviousness, the Office Action fails to include an indicated reasonable expectation of success. M.P.E.P. § 2143. There is no evidence that one would be able to successfully combine the cited references in that both references describe eyewear having apparatus, including circuitry, housed (or co-molded) in both ear pieces (or temples) of eyewear. It is not clear that one of skill in the art would be able to combine and fit the several components of Swab, et al. and Bylander into the ear pieces (or temples) of eyewear, as claimed.

Finally, with respect to the third requirement, even if the references were combined, the combination fails to teach all of the claimed elements. For example, with respect to Claim 22, neither Swab, et al. nor Bylander teaches or suggests, *inter alia*, "a first lens support supporting the first lens, the first lens support being configured to allow the first lens to pivot relative to the frame between at least first and second positions," as claimed. Therefore, the combination of Swab, et al. and Bylander does not render obvious at least Claim 22.

Claims 14 and 22 are therefore allowable over the cited references. Claims 15-21, which depend from Claim 14, and Claims 23-29, which depend from Claim 22, are therefore allowable for at least the same reasons. In addition, Claims 15-21 and 23-29 are patentable for the unique combination of elements recited therein. Applicants respectfully request withdrawal of the rejection of these claims.

#### The Applied Combination of Swab et al./Young Does Not Make Obvious Claims 14-21

Claims 14-21 stand rejected under 35 U.S.C. § 103(a) as being obvious over Swab et al. in view of Bylander. For many of the same reasons provided above with respect to the Swab, et al. and Bylander combination, Applicants respectfully traverse the present rejection.

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As discussed above, Swab, et al. teach eyewear with a transceiver for forming ad hoc networks. However, as admitted by the Office Action, nothing in Swab, et al. teaches or suggests any devices for changing the light attenuation provided by the lenses thereof.

Young teaches variable density spectacles having a pair of superposed iodine stained light polarizing elements, one of such elements being rotatable through an arc of less than 90 degrees to provide changes in the light transmitting functionality of the superposed elements; however, nothing in Young teaches or suggests that such a system should or could be combined with eyewear that has other electronic systems. Rather, as discussed in the Request for Reconsideration of March 30, 2005 and above, the Office Action relies on improper hindsight reasoning to provide the motivation for combining the references. In addition, there is no indicated likelihood of success in combining the cited references.

First, as discussed above, no motivation to combine the cited references is provided. Second, as discussed above, no reasonable indication of success in doing so is provided. Finally, neither a teaching or suggestion to make the claimed combination nor a reasonable expectation of success can be found in the cited references, and not based on the Applicant's disclosure.

Claims 14 and 22 are therefore allowable over the cited references. Claims 15-21, which depend from Claim 14, and Claims 23-29, which depend from Claim 22, are therefore allowable for at least the same reasons. In addition, Claims 15-21 and 23-29 are patentable for the unique combination of elements recited therein. Applicants respectfully request withdrawal of the rejection of these claims.

#### New Claims 30-33 Are Patentable Over The Cited Art

New Claims 30 and 31 depend from Claim 14 and new Claims 32 and 33 depend from Claim 22; therefore, Claims 30-33 are patentable at least for the reasons provided above. In addition, Claims 30-33 are patentable for the unique combination of features recited therein.

In addition, none of the cited references teach, inter alia, a cavity within an eyeglass frame, or a device, such as an MP3 player, positioned within a cavity, as claimed. Applicants therefore request allowance of Claims 30-33.

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Request For Telephone Interview

In view of the forgoing, the Application is in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, Applicants' undersigned attorney of record hereby formally requests a telephone interview with the Examiner. Applicants' attorney can be reached directly at (949) 721-6384 or at the number provided below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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